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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/638,989	08/11/2003	Robert Greenberg	S230-USA	6557

28284 7590 08/20/2008

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EXAMINER	
DIETRICH, JOSEPH M	
ART UNIT	PAPER NUMBER
3762	
MAIL DATE	DELIVERY MODE
08/20/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/638,989	GREENBERG ET AL.	
	Examiner	Art Unit	
	Joseph M. Dietrich	3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 June 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/11/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I (claims 1 – 15) in the reply filed on 4 June 2008 is acknowledged.

Claim Objections

2. The phrase "exposing an electrical conductor" in lines 4 – 5 of claim 1, does not positively recite the conductor. It is suggested to first positively recite "an electrical conductor" before reciting the conductor is located in the aperture.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berrang et al. (U.S. Patent Application Publication 2003/0109903).

Regarding **claims 1 – 8 and 12 – 14**, Berrang discloses a first insulation layer (e.g. 11 in Fig. 1); a second insulation layer that defines at least one aperture (e.g. 14) exposing an electrical, biocompatible conductor comprised of titanium (e.g. 13 and paragraph 53); said conductor located between the two insulation layers (e.g. Fig. 1); and at least one other polymer layer that is either located between the first insulation layer and the conductor (e.g. 12) or not in between the two insulation layers (e.g. 10); but fails to disclose specifically that the two insulation layers are comprised of polyparaxylylene (and more specifically Parylene) and the other polymer layers are comprised of polyimide. However Berrange teaches that both Parylene and polyimide can be used as biocompatible insulation as set forth in paragraphs 1 and 80. Furthermore both materials are well known in the art as biocompatible insulation. It would have been obvious to modify insulation layers (11 and 14) and polymer layers (10 and 12) as taught by Berrang with Parylene and polyimide, respectively, since such a modification would provide the predictable results of optimizing the insulation properties of the device surrounding a conductor.

Regarding **claims 9 – 11**, the phrases "suitable for stimulating a nerve," "suitable for sensing a signal from a nerve," and "suitable for detecting or transmitting signals to living tissue" is functional language. The conductor as taught by Berrang is capable of

performing these functions as it is titanium and allows an electrical current to travel through it.

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berrang et al. as applied to claim 14 above, and further in view of Strandberg et al. (U.S. Patent 5,476,496).

Regarding **claim 15**, Berrang discloses the claimed invention except for titanium nitride. Strandberg teaches that it is known to use titanium nitride as a biocompatible coating as set forth in column 4, lines 35 – 39. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the coating as taught by Berrang with the titanium nitride coating as taught by Strandberg, since such a modification would provide the predictable results of providing a flexible layer around the entire device that is safe and effective for implantation in the body.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph M. Dietrich whose telephone number is (571)270-1895. The examiner can normally be reached on M-F, 8:00 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M. D./
Examiner, Art Unit 3762
8/15/08

/Angela D Sykes/
Supervisory Patent Examiner, Art Unit 3762